

Remarks/Arguments

The Rejection of Claims 1-5, 8, 11 and 16 Under 35 U.S.C. §102(b)

The Examiner rejected Claims 1-5, 8, 11 and 16 under 35 U.S.C. §102(b) as being anticipated by United States Patent Number 4,643,653 (Masaka et al.), hereafter referred to as “Masaka ‘653.” Applicants respectfully traverse the rejection.

In item 6 of the Office Action dated February 28, 2006 the Examiner stated that Claim 12 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 1 has been amended to include the limitations of Claim 12, which has been cancelled. Therefore, Claim 1 is novel with respect to Masaka ‘653. Claims 2-5, 8, 11, and 16, dependant upon Claim 1, enjoy the same distinction with respect to the cited reference.

Further, Applicants reassert the following arguments:

Masaka ‘653 does not teach integral inlet and outlet ports

The Examiner has cited elements 11a and 12a in Figs. 5 and 9 as inlet and outlet ports. However, Masaka ‘653 has a different definition and description for inlet and outlet ports: “[p]ipes 13 and 14 *constituting fluid outlet and inlet ports...*” at column 3, line 33. (emphasis added). Moreover, Masaka ‘653 never mentions or alludes to openings 11a or 12a as being ports, instead, Masaka ‘653 defines 11a and 11b as “*cylindrical portions 11a and 12a*” (col. 3, lines 34 and 35) (emphasis added).

The Examiner has asserted that making the inlet and outlet ports integral is merely an engineering choice. Applicants disagree. In *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form “a single integral and gaplessly continuous piece.” Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece

gapless support structure, showing insight that was contrary to the understandings and expectations of the art.

Similarly, Masaka '653 perceives a need for the structure to not be an integral, one piece design. It is contradictory for Masaka '653 to state that "[i]t is another object of the present invention to provide a simple electromagnetic pump with a small number of constituting parts" (at column 2, line 9-11) and still have pipes 13 and 14 as non-integral pieces unless they were non-integral for a specific reason. In other words, if pipes 13 and 14 were integral, this would mean two less parts of the pump. Since this is against the object of the invention, Masaka '653 must disclose some other purpose of having non-integral parts. This purpose is detailed in column 4, at line 11-16, where pipe 13 "extends inside the sleeve member 15 for a predetermined length to form an annular space serving as an annular pulsation absorption chamber 23 around the pipe 13."

The Examiner has disregarded the definitions in Masaka '653

The Examiner does not have the liberty to alter the definitions for inlet and outlet ports in Masaka '653. The Masaka '653 definition of the term port is the definition that must be used in light of Claim 1. The Federal Circuit held in *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998) and cited in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005):

It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field. The inventor's words that are used to describe the invention--the inventor's lexicography--must be understood and interpreted by the court as they would be understood and interpreted by a person in that field of technology. Thus the court starts the decision making process by reviewing the same resources as would that person, viz., the patent specification and the prosecution history.

Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Thus, it is inappropriate for the Examiner to "look at the ordinary meaning of the term . . . in a vacuum. Rather, [he] must look at the ordinary meaning in the context of the written

description and the prosecution history.” *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) (*cited in Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005)).

Further, the definition in Masaka ‘653 is not repugnant to the ordinary meaning. For example, Merriam Webster’s Collegiate Dictionary defines the word “port” as “2 a: *an opening for intake or exhaust of a fluid*” and “b: the *area of opening* in a cylinder face of a passageway...” (emphasis added). The Examiner incorrectly interprets this definition as to refer to portions 11a and 12a in the interior of the invention of Masaka ‘653, but this is contrary to the preceding definition of “port” and the definition in Masaka ‘653. Portions 11a and 12a are better described as providing internal passageways within the pump taught by Masaka ‘653.

Figures 5 and 9 are not enabling

The Examiner has cited Figures 5 and 9 of Masaka ‘653, however, these figures show disassembled components of the pump of Masaka ‘653 and cannot be used to teach a pump housing with integral inlet and outlet ports. That is, one skilled in the art could not build the present invention pump using Figures 5 and 9 as a teaching guide. First, 11a and 12a are sub-components of the pump and the openings that the Examiner refers to are designed solely to receive other components, specifically, the unambiguously defined inlet port 14 and outlet port 13, respectively. It is inappropriate for the Examiner to dismantle the Masaka ‘653 invention into its multitude of interdependent components and arbitrarily assign functions and definitions that are not contemplated by or presented by Masaka. For example, calling internal passageways in the housing body and lid as inlet and outlet ports, in clear contradiction of Masaka’s own teachings and definitions.

Figures 5 and 9 teach a sub-assembly of a pump. Assuming *arguendo* that portions 11a and 12a teach a port, this port is only present outside of the fuel pump that Masaka ‘653 teaches. For example, Masaka ‘653 teaches that pipes 13 and 14 are each separate from and brazed to portions 11a and 12a, respectively. That is, pipes 13 and 14 are not integral to any other portion of Masaka’s pump.

Portions 11a and 12a are not enabling as ports. The very structure of 11a and 12a are unsuitable for inlet or outlet ports. Masaka does not teach integral inlet and outlet ports, therefore, Masaka does not anticipate Claim 1.

Applicant courteously requests that the rejection be removed.

Rejection of Claims 6 and 9 under 35 U.S.C. §103(a)

The Examiner rejected Claims 6 and 9 under 35 U.S.C. §103(a) as being unpatentable over United States Patent Number 4,643,653 (Masaka et al.). Applicants respectfully traverse the rejection.

In item 6 of the Office Action dated February 28, 2006 the Examiner stated that Claim 12 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 1 has been amended to include the limitations of Claim 12, which has been cancelled. Therefore, Claim 1 is patentable over Masaka '653. Claims 6 and 9, dependant upon Claim 1, enjoy the same distinction with respect to the cited reference.

Applicants further reaffirm the following arguments:

Masaka '653 does not teach, suggest, or motivate integral inlet and outlet ports with integral nipples arranged to receive hoses

The Examiner stated in the rejection of Claims 6 and 9: "Masaka teaches that the inlet port further comprises a nipple 14, operatively arranged for coupling with a fuel hose." The Examiner then states: "Masaka does not teach that the inlet port is integral with the nipple 14." Masaka clearly defines 14 as an inlet port. In fact, Masaka '653 never uses the term "nipple." In short, the Examiner failed to apply the definition provided by Masaka '653 for elements 13 and 14, and has applied new definitions that have no support in Masaka '653.

Assuming *arguendo* that portions 12a and 11a are inlet and outlet ports, which they are not, these portions are clearly not provided with integral nipples. Nipples would serve no function since these parts are internal to the pump and function to hold ports 14 and 13, respectively. The portions also are not arranged to receive hoses. Again, the portions are internal to the pump. Inlet and outlet ports 14 and 13, separate from portions 12a and 11a,

respectively, are arranged to receive hoses. Even if portions 12a and 11a were on the exterior of the pump, which they are not, these portions are clearly not arranged to receive hoses.

The Examiner has applied impermissible hindsight

The Examiner has provided no motivation to modify Masaka '653 and instead has fallen prey to impermissible hindsight by applying the teachings of the subject invention against itself. The Examiner states that a reduction in manufacturing cost and time by making a one-piece construction is the motivation. In fact, a one-piece construction would greatly increase the cost of making Masaka's pump. Masaka '653 teaches that the pump components are made of metal. It is well known that casting one-piece metal parts or forming one-piece parts from powdered metal can be very expensive. In contrast, Masaka '653 makes use of cheap and easily made stamped parts. Further, as noted above, Masaka '653 explicitly states that making the pump of component metal parts is preferable: "[t]he body 11 and 12 can be easily formed by pressing metal plates." (column 3, lines 35-36).

Applicant courteously requests that the rejection be removed.

Rejection of Claims 7, 10, and 19 under 35 U.S.C. §103(a)

The Examiner rejected Claims 7, 10, and 19 under 35 U.S.C. §103(a) as being unpatentable over United States Patent Number 4,643,653 (Masaka et al.) in view of United States Patent Number 4,306,842 (Masaka), hereafter referred to as "Masaka '842." Applicants respectfully traverse the rejection.

Claim 1

In item 6 of the Office Action dated February 28, 2006 the Examiner stated that Claim 12 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 1 has been amended to include the limitations of Claim 12, which has been cancelled. Therefore, Claim 1 is patentable over Masaka '653 and Masaka '842. Claims 7 and 10, dependant upon Claim 1, enjoy the same distinction with respect to the cited reference.

The Examiner states that Claims 7 and 10 are unpatentable over Masaka '653 in view of Masaka '842, wherein Figure 2 of Masaka '842 teaches insert inlet port 23 comprising threads in order to easily remove/replace said insert from said inlet port in case of failure or maintenance. Element 23 in Masaka '842 is a threaded fixture for holding pipe 45 – it is not an inlet port either by the standard definition (see arguments *supra* regarding Claim 1 and Masaka '653) or by the terminology of Masaka '842. Pipes 45 and 46 perform the function of inlet and outlet ports and are analogous to the inlet and outlet ports identified in Masaka '653. Therefore, the inserts the Examiner references are analogous to the inlet and outlet ports. That is, the Examiner's argument is that separate, threaded fixtures are useful to replace non-integral inlet and outlet ports. Masaka '842 does not teach threading ports.

For all the reasons noted above, Claim 1 is patentable over the cited references. Claims 7 and 10, dependent from Claim 1, enjoy the same distinction with respect to the cited references.

Claim 19

In item 6 of the Office Action dated February 28, 2006 the Examiner stated that Claim 12 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. That is, the limitations of Claim 12 are not taught, suggested, or motivated by Masaka '653 or Masaka '842. Claim 19 has been amended to include the limitations of Claim 12. Therefore, Claim 19 is patentable over Masaka '653 and Masaka '842.

Masaka does not teach insert and outlet ports threaded to insert and remove nipples

Amended Claim 19 recites: "a two piece housing operatively arranged to house said pump and said coil, said two piece housing is comprising a first material, wherein a first piece of said two piece housing comprises a threaded insert inlet port and a second piece of said two piece housing comprises a threaded insert outlet port; said threaded insert inlet and outlet ports comprising a second material *and wherein said inlet port and said outlet port are adapted for threadably inserting and removing threaded nipples.*" (emphasis added). The arguments *supra* regarding Claims 7 and 10 are applicable to Claim 19.

Further, Figure 2 of Masaka shows that fixtures 23 and 24 are threaded for attachment to the body of the pump, but that no such threaded arrangement is used for the pipes. Nor does Masaka suggest or motivate such a threaded arrangement for the pipes.

Masaka fails to teach, suggest, or motivate all the elements of Claim 19. Therefore, Masaka fails to establish a *prima facie* case of obviousness with respect to Claim 19.

Applicant courteously requests that the rejection be removed.

New Claim 20

Rejection under 35 U.S.C. §102(b) by United States Patent Number 4,643,653 (Masaka et al).

The Examiner had rejected Claims 1-5, 8, 11 and 16 under 35 U.S.C. §102(b) as being anticipated by United States Patent Number 4,643,653 (Masaka et al.).

Masaka '653 does not teach integral inlet and outlet ports

Claim 20 recites integral inlet and outlet ports. The arguments made regarding the rejection of Claim 1 are applicable to Claim 20 and in the interest of brevity are not repeated here.

Masaka '653 does not teach inlet and outlet ports with integral nipples

Claim 20 recites: "...said inlet port comprises a first integral nipple," and, "...said outlet port comprises a second integral nipple," The integral nipples were recited in Claims 6 and 9, respectively. The Examiner admitted that Masaka did not anticipate these limitations by not including Claims 6 and 9 in the above-referenced rejection. Therefore, Claim 20, which recites the limitations of Claims 6 and 9, is novel with respect to Masaka '653.

Masaka '653 does not teach inlet and outlet ports arranged for coupling with hoses

Claim 20 recites: "...said inlet port is operatively arranged for coupling with a first fuel hose;" and "...said outlet port is operatively arranged for coupling with a second fuel hose," The preceding limitations were recited in Claims 6 and 9, respectively. The Examiner admitted that Masaka did not anticipate these limitations by not including Claims 6 and 9 in the above-referenced rejection. Therefore, Claim 20, which recites the limitations of Claims 6 and 9, is novel with respect to Masaka '653.

For all the reasons noted above, Claim 20 is novel with respect to Masaka '653.

Rejection of Claims 6 and 9 under 35 U.S.C. §103(a)

The Examiner rejected Claims 6 and 9 under 35 U.S.C. §103(a) as being unpatentable over United States Patent Number 4,643,653 (Masaka et al.).

Applicants have shown that Masaka '653 does not teach all the elements of Claim 20. Further, Masaka '653 does not suggest or motivate the elements not taught by Masaka '653. Specifically, Masaka does not teach, suggest, or motivate integral inlet and outlet ports.

Claim 20 recites the Claim 6 and 9 limitations of integral nipples arranged for coupling to hoses. Therefore, the arguments *supra* regarding Claims 6 and 9 are applicable to Claim 20 and are not repeated here.

Masaka teaches against a plastic molded housing body

Claim 20 recites: "...said housing and said end cap are made from molded plastic." Regarding Claim 5, which recites a molded body for the housing, the Examiner stated "where a product or process claim...is rejected over prior art...that appears to be identical as is the case here, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an unobvious difference between the two." Masaka '653 teaches that "[t]he body 11 and 12 can be easily formed by pressing metal plates." (column 3, lines 35-36). Masaka '653 perceives the need of a heat conductive body such as a metal to allow "heat radiation of the transistor 32". (column 5, lines 40-44). "[t]he body 11 and the lid 12 of the pump housing also serve as yokes for forming a magnetic path from an excitation coil".

Thus, Masaka '653 teaches that a pump must necessarily have a metal housing and teaches against the use of plastic, since plastic cannot provide the heat conduction and magnetic path that Masaka requires.

For all the reasons noted above, Claim 20 is patentable over Masaka '653.

Attorney Docket No. MOTP:102US
U.S. Patent Application No. 10/695,360
Reply to Office Action of February 28, 2006
Date: June 8, 2006

Rejection of Claims 7, 10 and 19 under 35 U.S.C. §103(a)

The Examiner rejected Claims 7, 10, and 19 under 35 U.S.C. §103(a) as being unpatentable over United States Patent Number 4,643,653 (Masaka et al.) in view of United States Patent Number 4,306,842 (Masaka).

Claim 20 does not recite a threaded insert, therefore, the above rejection is irrelevant to Claim 20.

Conclusion

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,



C. Paul Maliszewski
Registration No. 51,990
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

Dated: June 8, 2006

CPM/MAR